The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte BERNARD DASKAL

Appeal 2007-0137
Application 09/489,655
Technology Center 3700

Decided: September 19, 2007

Before JENNIFER D. BAHR, LINDA E. HORNER, and ANTON W. FETTING, *Administrative Patent Judges*.

BAHR, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

Bernard Daskal (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 1 and 5-7, the only pending claims. Claims 1 and 5-7 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Datta (US 4,801,494, issued January 31, 1989) and as unpatentable

over Van Iten (US 5,188,625, issued February 23, 1993). We have jurisdiction over this appeal under 35 U.S.C. § 6 (2002).

A paper styled "RULE 1.132 DECLARATION OF SHERRY DASKAL" (hereinafter "Daskal Declaration") is appended to the Appeal Brief (filed October 18, 2002) as Exhibit 6 and referred to on page 15 (footnote 4) of the Appeal Brief. The Appeal Brief does not indicate whether the Daskal Declaration was previously of record in the application and, if so, the date of its submission. Our review of the electronic records for this application did not reveal submission of the Daskal Declaration prior to its submission as Exhibit 6 in the Appeal Brief. The Examiner's Answer (mailed October 3, 2003) makes no reference to the Daskal Declaration. Therefore, the record is not clear as to whether the Daskal Declaration has been entered and considered by the Examiner.

The Appeal Brief also refers to a paper styled "RULE 1.132 DECLARATION OF RABBI SHMUEL NEIMAN" (hereinafter "Neiman Declaration") appended as Exhibit 4 (Appeal Br. 4, 5, 17, 18). Our review of the electronic record for this application revealed that the Neiman Declaration was submitted in the application on January 23, 2002, but did not reveal any reference to the Neiman Declaration by the Examiner. The record thus is not clear as to whether the Neiman Declaration has been considered by the Examiner.

We also note that neither the Neiman Declaration nor the Daskal Declaration meets the requirements of 37 C.F.R. §§ 1.132 and 1.68 in that neither includes a warning that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. § 1001) and may jeopardize the validity of the application or any patent issuing thereon.

In light of the unclear status of the Neiman Declaration and the Daskal Declaration, both of which are relied upon by Appellant in the Appeal Brief in argument against the standing rejections, this panel finds that it would be imprudent to decide this appeal without clarification as to their status. Accordingly, this application is remanded to the Examiner, pursuant to 37 C.F.R. § 41.50(a)(1), for clarification as to the status of the Neiman Declaration and the Daskal Declaration, including a statement as to whether they have been entered and considered and, if they have been entered and considered, an explanation as to how they factored into the Examiner's analysis of the patentability of the claimed subject matter in weighing the totality of the evidence used to reach the ultimate conclusion of obviousness. *See Richardson-Vicks Inc. v. Upjohn Co.*, 122 F.3d 1476, 1483, 44 USPQ2d 1181, 1187 (Fed. Cir. 1997).

ORDER

Accordingly, it is ORDERED that the application is remanded to the Examiner for appropriate action in regard to the issues discussed above.

This remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

REMANDED

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